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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,451
Filing Date: December 31, 2003
Appellant(s): KONINGSTEIN ET AL.

John C. Pokotylo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/25/2007 appealing from the Office action mailed 10/23/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is slightly incorrect. A corrected statement of the status of the claims is as follows:

Claims 1, 2, 5-15, 18-43, 46-56, 59-84, and 86-88 are pending.

Claims 2, 12, 13, 15, 25, 26, 28, 38, 39, 43, 53, 54, 56, 66, 67, 69, 79, and 80 are rejected under 112 2nd as omitting essential elements.

Claims 12, 25, 38, 53, 66, and 79 are rejected under 112 2nd as being indefinite.

Claims 1, 5-10, 14, 18-23, 27, 29-36, 40-42, 46-51, 55, 59-64, 68, 70-77, 81-84, and 86-88 are rejected under 102(e) as being anticipated by Paine (U.S. Pub No. 2003/0055816).

Claims 2, 11-13, 15, 24-26, 28, 37-39, 43, 52-54, 56, 65-67, 69, and 78-80 are rejected under 103 as being unpatentable over Paine.

Claims 3, 4, 16, 17, 44, 45, 57, 58, and 85 are canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 1, 2, 5-15, 18-41, 83, 84, and 86-88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20030055816

PAINE

3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-4, 12, 13, 15-17, 25, 26, 28-30, 38, 39, 43-45, 53, 54, 66, 67, 69-71, 79, and 80 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

Regarding claims 2-4, 15-17, 28-30, 43-45, 56, and 69-71, the omitted elements relate to the following: No advertisements are previously claimed, only keywords with a primary function of targeting advertisements. In the above claims, limitations are being recited on advertisements that

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have never actively been targeted or served. There appears to be a missing step of targeting or serving advertisements.

Regarding claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, the omitted elements relate to the following: It is unclear as to how unused inventory and unused ad spots are determined. No inventory of advertisements is previously claimed, nor is there any mention that part of that unsaid inventory may be unused. Examiner recommends the defining a webpage with a finite number of ad spots, the showing of advertisements on the webpage, and the determining that not all ad spots are filled to define unused inventory.

Claims 12, 25, 38, 53, 66, and 79 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12, 25, 38, 53, 66, and 79, these claims recite the limitation "available ad spots". There is insufficient antecedent basis for this limitation in the claims.

Claims 1, 3-10, 14, 16-23, 27, 29-36, 40-42, 44-51, 55, 59-64, 68, 70-77, 81-84, and 86-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine (U.S. Pub. No. 2003/0055816). Paine shows a method and apparatus for recommending search terms to an advertiser that includes all of the limitations recited in the above claims.

Referring to claims 1, 14, 42, 55, 86, and 87, Paine teaches a method and apparatus for determining one or more ad targeting keywords comprising accepting at least one category (search terms in the initial list are considered to be categories), determining one or more keywords using the accepted at least one category, providing the determined one or more keywords as suggested targeting keywords to an advertiser, accepting advertiser input in response to the suggested targeting

keywords, and determining whether or not to provide at least some of the determined one or more keywords as targeting keywords for an ad using the accepted advertiser input (Paragraph 0107, Sentence 1). If keywords are gathered using existing information (as taught by Paine), this is a step of looking up those keywords. Since categories are used to look up keywords, this look-up is taken to be a specific association.

Referring to claims 3, 4, 16, 17, 29, 30, 44, 45, 70, and 71, Paine teaches the determining of at least one category using ad creative information and information from a landing webpage of the advertiser (Abstract, Sentence 2). Examiner considers an advertiser website to contain ad creative information. Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7).

Referring to claims 5, 18, 31, 46, 59, and 72, Paine teaches inverted an keyword index in which categories are provided as lookup keys to keywords (Paragraph 0080, Sentences 1-4). Examiner considers each of Paine's subaccounts (which refer to different keywords) to be a different category.

Referring to claims 6, 19, 32, 47, 60, and 73, Paine teaches the performing of qualification testing of the determined one or more keywords to determine if a keyword is qualified or unqualified for use as an ad targeting keyword and the providing of those qualified keywords as ad targeting keyword (Abstract, Sentence 3).

Referring to claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77, Paine teaches the tracking of the performance of the ads served using an ad targeting keyword. Paine's tracking is performed in general as well as across specific categories, including the accepted category (Paragraph 0087, Sentences 5-7).

Referring to claims 27, 40, 41, 68, 81-84, and 88, Paine teaches a method and apparatus for generating one or more keywords as candidates for use as ad targeting keywords, comprising the

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accepting of ad information, the determining of one or more categories using the accepted ad information (Abstract, Sentences 1-3), the recommending of at least one of the one or more of the categories to an advertiser, and the accepting of feedback with respect to the recommended one or more categories (Paragraph 0107, Sentence 1). The search terms referred to by Paine are viewed as serving constraints for the advertisements. By comparing an advertiser to other similar advertisers (Abstract, Sentence 3), the system would have to determine the initial advertiser's product category. If keywords are gathered using existing information (as taught by Paine), this is a step of looking up those keywords. Since categories are used to look up keywords, this look-up is taken to be a specific association.

Claims 2, 11-13, 15, 24-26, 28, 37-39, 43, 52-54, 56, 65-67, 69, and 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816).

Referring to claims 2, 15, 28, 43, 56, and 69, Paine's invention doesn't teach a tool that keeps track of negative ad targeting keywords. Paine does teach that it is well known to have a tool to keep track of two lists, a list of good words for an advertiser's site and a list of negative keywords having no relation to the advertisers site or content (Paragraph 0008, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include negative keywords into the system of Paine. This would allow more accuracy in relation to relevant keywords.

Referring to claims 11, 24, 37, 52, 65, and 78, Paine teaches a system for recommending ad targeting keywords for ads displayed on a search site. Paine doesn't go into detail about the type of space that will be used for the ad on the search site. Official notice is taken that it is well known when a new advertisement is added to a search page, it will be added to an ad spot that would otherwise be unused. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to specify an advertisement as being served on a portion of the webpage that would otherwise be unused. This would keep the operator of the search site from overlapping other information with an advertisement.

Referring to claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, Paine teaches filling unused inventory ad spots with unpaid listings generated by a search engine (Paragraph 0075, Sentences 10-11). Paine does not teach any attempt to fill those unused spots with other paying advertisements. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the webpage owner would want to recommend keywords to a paying advertiser for which there were more spots available. This will ensure that less ad spots will be unpaid-for.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5-15, 18-41, 83, 84, and 86-88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with

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the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1, 2, 5-15, 18-41, 83, 84, and 86-88 fail to meet the above requirements.

(10) Response to Argument

Before responding to Appellant's arguments, Examiner would like to briefly discuss the broad nature of Appellant's claims. With respect to claim 1, Appellant merely recites three steps, accepting a word (which the Appellant calls a category), looking up other words based on the accepted word, and returning or providing the looked up words (presumably to some end user, possibly the one from which the category word was accepted in the first step). The language at the end of the claim "as one or more ad targeting keywords" is merely intended use, as there are no positively claimed steps of serving advertisements using these search terms as serving constraints. Using the broadest reasonable interpretation, an electronic thesaurus capable of accepting a word (or category, if this is the descriptive word Appellant feels more comfortable using) and returning synonyms will read on the first claim. Whether a user wishes to use an electronic thesaurus to write a research paper, or discover additional ad targeting keywords would be a moot point. Other than calling the user an "advertiser" in some of the independent claims (the title of the user, whether it be "advertiser", "searcher", "examiner", or "Billy", carries very little patentable weight), Appellant does not positively claim any advertising functionality in the independent claims. This analysis of the claims will lead us directly to Appellant's arguments of the 112 rejections.

Response to Appellant's argument of the 112 rejection of claims 2, 15, 28-30, 43, 56, and 69-71 for omitting essential steps. Appellant argues "neither targeting, nor serving, are essential steps". Claim 2 defines negative keywords as making an advertisement ineligible to be served. There is no serving of advertisements however. Whether Appellant's intended invention serves the

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advertisements or accepts an initial word (category) from a user who serves advertisements, the fact remains that in the current independent claims, no advertisement is being served or required to be served, Appellant's claims do not even accept information specifically from a source that serves advertisements. The question remains how a negative keyword may make an advertisement ineligible to be served when no advertisements are ever served by anyone in the first place.

Response to Appellant's argument of the 112 rejection of claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80 for omitting essential steps. Appellant argues "the claims do not require determining unused ad spots or unused inventory", "such information might already be available and simply accepted", and "the Appellant never indicated that such a determination is necessary or essential". Examiner would like to point out that there is never an active step in the claims of "accepting unused ad spot or unused inventory information" (which would be a step of determining the unused ad spots). In fact, there is no web page with advertisements in the claims, let alone a web page with a set number of ad spots. To reiterate, the independent claims merely recite looking up words based on other information. There is an essential step missing in the claims to link claim 1 with claim 12 (and subsequently, claim 13).

Regarding the 112 rejection of claims 12, 25, 38, 53, 66, and 79 for being indefinite, Appellant does not appear to have argued this rejection. Seeing as how ad spots do not appear in the parent claims, there does not appear to be a valid argument to be made for "available ad spots" having proper antecedent basis. How can there be "available ad spots" when no ad spots exist whatsoever.

Response to Appellant's argument of Examiner's interpretation of "category" and "keyword". Examiner brings forth the point that figure 9 of Paine uses "automobile" as an example of a search term. On page 17 of the Appeal Brief, Appellant refers to "automobile as an example of a category. Appellant currently argues "the fact that a particular term might be used as a label

representing a category does not mean that the same term, when used as a search term, represents a category". The category of Appellant's invention is merely a word used to look up other words. The search term of Paine is merely a word used to look up other words. A category may simply be defined as a term in which to describe other data which may fall under the umbrella of the original term. This definition also applies to the search terms of Paine. Much like the words "category" and "keyword", "trash" and "garbage" are two words with the same meaning. Under the Appellants argument, "trash" could not be used in place of the word "garbage", because although they mean the same thing, they are different words. Just because "category" is a different word than "keyword", does not mean these two terms do not have the same meaning in the context of Appellant's invention. They are both merely words used to look up other words.

More importantly, Appellant never specifically defines "category" in the specification. In figure 3 of Appellant's drawings, a category may be used to look up a keyword while a keyword may also be used to look up a category. In one instance, the "keyword" word is the category used to look up the "category" word. Apparently, Appellant's specification uses "category" and "keyword" interchangeably to perform the same functions, yet Appellant argues they are not the same. Examiner feels that this is simply an argument over semantics, and that category and keyword are equivalent in the context of the current application and the prior art.

Response to Appellant's argument of the 102(e) rejection of claims 1, 14, 42, and 55,
Appellant argues that neither spidering, nor collaborative filtering, nor their combination, teach an act of or means for determining one or more keywords using at least one category. Appellant state's that "spidering may provide recommended search terms which a new advertiser may accept or reject" and "collaborative filtering may be used to provide an updated list of search terms which may be accepted or rejected" (both of these concepts are taught by Paine). Examiner considers a search term to be a category for the reasons stated above. Based on this information, Paine reads on the above claims.

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Appellant further argues “this collaborative filtering process to get terms (alleged to be keywords) used by other advertisers from existing terms (alleged to be categories) is not using a category to lookup one or more keywords”. Once again, Examiner would like to point out that the term “looking up” is a broad term. Getting terms used by other advertisers from existing terms is a step of looking up one set of terms based on another.

Response to Appellant’s argument of the 102(e) rejection of claims 86-88, Appellant argues “the use of collaborative filtering in the Paine Publication to get terms (alleged to be keywords) used by other advertisers from existing terms (alleged to be categories) does not specifically associate the existing terms with the terms used by other advertisers”. If a program is able to get one set of terms from another set of terms, those two sets of terms have to be inherently “associated”. If the terms were not associated whatsoever, then no terms would be returned. Once again, Examiner relies on the fact that “associated” is a very broad term. One term that is listed in a thesaurus as a synonym of another term is an example of an association.

Response to Appellant’s argument of the 102(e) rejection of claims 29, 30, 70, and 71, Appellant argues “although an advertiser website might be linked to an ad, these claims recite that the ad includes ad creative information for rendering the ad and an address of a landing webpage linked from the ad”. Examiner would like to point out that Appellant is limiting an advertisement that has not been claimed. The parent claims recite “ad information”. “Ad information” is a broad term that could be interpreted any number of ways. It does not, however, mean that an advertisement itself has been claimed. Paine does indeed, however, teach this improperly claimed advertisement content at Figure 7.

Response to Appellant’s argument of the 102(e) rejection of claims 5, 18, 31, 46, 59, and 72, Appellant argues “Examiner is interpreting category inconsistently to mean both terms and advertiser subaccounts”. The first 2 sentences of Paragraph 0080 of Paine state “As shown in FIG. 9,

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the search listings may be displayed as “subaccounts.” Each subaccount comprises one search listing group, with multiple subaccounts residing within one advertiser account”. The prior art itself says search listings may be displayed as subaccounts. Clearly, this is not a case of inconsistent interpretation. Examiner is merely relying on the teachings of the prior art.

Response to Appellant’s argument of the 102(e) rejection of claims 6, 19, 32, 47, 60, and 73, Appellant argues “the Examiner’s interpretation of “qualification testing” is inconsistent with how one skilled in the art would interpret this term in light of the specification”. However, Appellant does not explicitly define the term “qualification testing” in the specification. Rather, on page 24 of the Appeal Brief, Appellant states “the specification of the present application provides an example of such qualification testing” and cites the specification as stating “Figure 8 is a flow diagram of an exemplary method 800 that may be used”. These are examples of possible qualification testing, but the specification does not concretely define such testing. The specification does not limit the invention to exclude the type of qualification testing Examiner has found within Paine. Since the Examiner prides himself as one who is skilled in the art, Examiner feels that the interpretation of qualification testing is indeed not inconsistent and is appropriate due to the broad nature of the term “qualification testing”.

Response to Appellant’s argument of the 102(e) rejection of claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77, Appellant argues “merely tracking performance does not teach using such performance for purposes of performing qualification testing of keywords”. Paine teaches tracking performance. The reasons for the tracking (for purposes of performing qualification testing) are intended use and is given little patentable weight. Paine still teaches both qualification testing and performance tracking.

Response to Appellant’s argument of the 103(a) rejection of claims 2, 15, 28, 43, 56, and 69, Appellant argues that Paine teaches “positive and negative scores assigned to keywords for

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determining whether a new advertiser is similar to an existing advertiser.” Paragraph 0008 of Paine recites: “This tool keeps track of two lists; an accept list of good words for an advertiser’s site, and a reject list of bad words or words that have no relation to the advertiser’s site or it’s content”.

Examiner feels that this is sufficient material to read over the above claims and the rejection still stands.

Response to Appellant’s argument of the 103(a) rejection of claims 11, 24, 37, 52, 65, and 78, Examiner contends that a web page developer would not put 2 advertisements on top of one another in the interest of both items being viewable. Appellant argues “the Examiner’s position ignores the fact, understood by those skilled in the art, that an advertisement can displace another advertisement from an ad spot”. Examiner agrees that this is one plausible interpretation of the broad claim language. However, another plausible interpretation suggests that if an advertisement is to be placed on a webpage, it would not be placed in a spot that is currently used by another advertisement. This would block the view of the advertisement that was originally in that position. This interpretation meets the broad claim language, and is indeed an interpretation that would be used by one skilled in the art.

Response to Appellant’s argument of the 103(a) rejection of claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, Appellant argues “these claims pertain to qualification testing of targeting keywords”. Examiner would like to point out that the above claims, as well as the parent claims from which they depend, recite any limitations of qualification testing. Appellant further argues “by ordering keywords based on number of unused ad spots associated with the keywords these claims provide advantages not even contemplated by the Paine publication”. In response to this argument, Examiner submits the following:

KSR forecloses the argument that a specific teaching is required for a finding of obviousness (citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). See Board decision *Ex parte Smith*, --USPQ2d-- , slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Further, It must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

In this case, one having ordinary skill in the art would simply need to understand that the information that could be theorized to have the most importance to a user would be the information that should be supplied first. This is essentially common sense for someone skilled in the art of advertising search terms when ordering lists of any kind. Once this common sense strategy of ordering lists is combined with Paine, the result is simply obvious.

A general response to all of Appellant's arguments, Appellant appears to be relying on the specification constantly in the arguments over the rejections. Examiner asserts that the claims are overly broad and do not actively claim a majority of the information in the specification on which the Appellant appears to base his arguments. Examiner would like to set forth that the Appellant is not able to claim "A method for determining keywords as set forth in the specification". While the prior art may not be identical to Appellant's intended invention, the Paine reference does indeed read over the broad nature of the claims as they currently stand. Just because a claim reads "qualification

testing” or “looking up categories”, this does not mean that the prior art teaches these limitations identically to the specification. Examiner asserts that anyone examining the current claims under their broadest reasonable interpretation would also apply the Paine reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment,

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affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Michael Bekerman /MB/
Examiner, Art Unit 3622

Eric Stamber/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622


Conferees:

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /VM/
Appeals practice Specialist



A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



RYAN W. SOGDANS
TECHNOLOGY CENTER DIRECTOR